9/03/04

AF/3629/

ATTORNEY DOCKET NO.
020431.0463

PATENT APPLICATION
09/156,334

In The United States Patent and Trademark Office
On Appeal From The Examiner To The Board
of Patent Appeals and Interferences

In re Application of:	Ranjit N. Notani et al.
Serial No.:	09/156,334
Filing Date:	September 18, 1998
Group Art Unit:	3629
Examiner:	Thomas A. Dixon
Title:	*Method and System for Managing Collaboration Within and Between Enterprises*

Mail Stop: Appeal Brief
Commissioner For Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

CERTIFICATE OF MAILING
BY EXPRESS MAIL

I hereby certify that this communication is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" under 37 C.F.R. § 1.10 on the date indicated below and is addressed to The Commissioner For Patents, Mail Stop: AF, P.O. Box 1450, Alexandria, Virginia 22313-1450.

Willie Jiles

Willie Jiles

Date: September 1, 2004

Exp. Mail Receipt No. EV 322185327 US

Dear Sir:

Appeal Brief

Appellants have appealed to the Board of Patent Appeals and Interferences from the decision of the Examiner mailed May 3, 2004, finally rejecting Claims 1-7, 10-12, 15-20, and 48. Appellants filed a Notice of Appeal on July 12, 2004. Appellants respectfully submit this Appeal Brief in triplicate with the statutory fee of $330.00.

09/07/2004 JBALINAN 00000086 09156334
01 FC:1402 330.00 OP

Real Party In Interest

This application is currently owned by i2 Technologies US, Inc., as indicated by:

an assignment recorded on October 30, 1998, in the Assignment Records of the United States Patent and Trademark Office at Reel 9579, Frames 0005-0010; and

an assignment recorded on July 30, 2001, in the Assignment Records of the United States Patent and Trademark Office at Reel 012037, Frames 0741-0752.

Related Appeals and Interferences

There are no known appeals or interferences which will directly affect or be directly affected by or have a bearing on the Board's decision regarding this appeal.

Status of Claims

Claims 1-7, 10-12, 15-20, and 48 are pending in this application. Claims 1-7, 10-12, 15-20, and 48 stand rejected pursuant to a final Office Action mailed May 3, 2004, and are all presented for appeal. All pending claims are shown in Appendix A.

Status of Amendments

All amendments submitted by Appellants were entered by the Examiner before the issuance of the final Office Action mailed May 3, 2004.

Summary of Invention

In particular embodiments of the present invention, a computer-implemented process may manage a workflow distributed among nodes of one or more enterprises (Page 36, Lines 18-22). The computer-implemented process may store a set of predefined functions that are to be performed at the nodes. (Page 36, Lines 22-25). In addition, the computer-implement process may interact with the workflow at the nodes to perform the predefined functions. (Page 36, Lines 25-27). In particular embodiments, the computer-implemented process may include a high-level collaboration generated by a global collaboration designer and a global collaboration manager and may be capable of managing a workflow across a number of nodes. (Page 36, Lines 29-34). The predefined functions may include functions for

generating, deploying, monitoring, or otherwise interacting with a workflow. (Page 37, Lines 1-3).

In particular embodiments, a computer-implemented process may generate a collaboration among a number of enterprises. The computer-implemented process may receive a preliminary collaboration (which may include a collaboration that other enterprises may comment on or modify) from a first enterprise and automatically (either immediately or in response to a particular event) transmit the received preliminary collaboration to a second enterprise. (Page 37, Lines 4-22). The computer-implemented process may then receive a response to the preliminary collaboration from the second enterprise. (Page 37, Lines 23-24). The response from the second enterprise may include one or more comments on the preliminary collaboration, one or more modifications to the preliminary collaboration, or another suitable response to the preliminary collaboration. (Page 37, Lines 24-27). Privileges granted to the second enterprise may determine what type of response is received from the second enterprise. (Page 37, Lines 29-30). After the computer-implemented process receives the response to the preliminary collaboration from the second enterprise, the computer-implemented process may automatically (either immediately or in response to a particular event) transmit the received response to the first enterprise. (Page 37, Lines 31-33). This process may continue, with any number of different enterprises reviewing and responding to the preliminary collaboration. (Page 10, Line 33, to Page 11, Line 4). These enterprises may be granted different privileges regarding the types of responses that may be provided, and thus different responses may be received from different enterprises. (Page 38, Lines 4-6). During this process, responses received from an enterprise may be transmitted to any number of different enterprises. (Page 10, Line 33, to Page 11, Line 4).

In particular embodiments, a computer-implemented process may deploy a collaboration generated by a first enterprise to a number of other enterprises. (Page 38, Lines 30-33). The first enterprise may generate the collaboration, and the computer-implemented process may transmit different predefined portions of the generated collaboration to different nodes of different enterprises. (Page 39, Lines 1-15). In particular embodiments, the enterprises may not execute their respective predefined portions of the deployed collaboration

until all or a certain number of enterprises approve the collaboration. (Page 39, Lines 16-18). In such embodiments, the computer-implemented process may request and receive approvals from the enterprises. (Page 39, Lines 19-20).

In particular embodiments, a computer-implemented process may monitor a collaboration across a number of different enterprises. (Page 39, Lines 25-27). The computer-implemented process may automatically query different nodes for data associated with execution of the collaboration at the different nodes, receive the queried data from the different nodes, and automatically transmit the received data to a monitoring system. (Page 39, Line 28, to Page 40, Line 16). An agent or other mechanism may perform a query, and the mechanism may operate at the queried node to reduce the use of network resources. (Page 39, Lines 30-34). The computer-implemented process may transmit data received in response to one or more queries to the monitoring system periodically or in response to the occurrence of a predefined event. (Page 40, Lines 3-4). These embodiments may allow execution of a collaboration to be monitored across a number of different enterprises, to be tracked at a hub or central location, or to be individually monitored by the enterprises. (Page 40, Lines 13-16).

Statement of Issue

Are Claims 1-7, 10-12, 15-20, and 48 patentable over U.S. Patent No. 5,745,687 to Randell ("*Randell*") in view of *Demo Proves It—Workflow Spec Lets Messages Flow* by Teschler ("*Teschler*") under 35 U.S.C. § 103(a)?

Grouping of Claims

Appellants have made an effort to group claims to reduce the burden on the Board. However, Appellants have concluded that not all claims properly stand or fall together. In the argument section of this Brief, Appellants present reasons why the claims of each group are separately patentable from the claims of other groups subject to the same rejection. Appellants have concluded that the following claims may be grouped together:

1. Group 1 may include Claims 1 and 3-4;
2. Group 2 may include Claim 2;
3. Group 3 may include Claims 5-7, 10-12, and 48;
4. Group 4 may include Claims 15-19; and
5. Group 5 may include Claim 20.

Argument

The rejection of Claims 1-7, 10-12, 15-20, and 48 under *Randell* in view *Teschler* is improper, and the Board should withdraw the rejection.

Claims 1-7, 10-12, 15-20, and 48 are Allowable over the Proposed *Randell-Teschler* Combination

A. Overview

The Examiner rejects Claims 1-7, 10-12, 15-20, and 48 under *Randell* in view *Teschler*. Appendix B includes a copy of *Randell*, and Appendix C includes a copy of *Teschler*. Appellants respectfully submit that the proposed *Randell-Teschler* combination fails to disclose, teach, or suggest limitations recited in Claims 1-7, 10-12, 15-20, and 48.

B. Standard

The question raised under 35 U.S.C. § 103 is whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art at the time of the invention. *See* 35 U.S.C. § 103(a). Accordingly, even if all elements of a claim are disclosed in various prior art references, which is certainly not the case here as discussed below, the claimed invention taken as a whole cannot be said to be obvious without some reason given in the prior art why one of ordinary skill at the time of the invention would have been prompted to modify the teachings of a reference or combine the teachings of multiple references to arrive at the claimed invention.

The M.P.E.P. sets forth the strict legal standard for establishing a *prima facie* case of obviousness based on modification or combination of prior art references. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references where combined) must teach or suggest all the claim limitations." M.P.E.P. § 2142, 2143. "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citations omitted).

In addition, the M.P.E.P. and the Federal Circuit repeatedly warn against using an applicant's disclosure as a blueprint to reconstruct the claimed invention. For example, the M.P.E.P. states, "The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art." M.P.E.P. § 2142. The governing Federal Circuit cases are equally clear. "A critical step in analyzing the patentability of claims pursuant to [35 U.S.C. § 103] is casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. . . . Close adherence to this methodology is especially important in cases where the very ease with which the invention can be understood may prompt one 'to fall victim to the insidious effect of a hindsight syndrome wherein that which only the invention taught is used against its teacher.'" *In re Kotzab,* 217 F.3d 1365, 1369, 55 U.S.P.Q.2d 1313, 1316 (Fed. Cir. 2000) (citations omitted).

C. Randell

Randell discloses data (such as design specifications and cost information) defining an activity being communicated from a computer system to an agent so that the agent can perform the activity. (Column 4, Lines 21-23; Column 5, Lines 36-46; Column 6, Lines 32-

36; Column 7, Lines 9-13; Column 7, Line 22, through Column 8, Line 47). *Randell* also discloses entry conditions for starting the activity. (Column 13, Lines 49-54; Figure 12). If the entry conditions are satisfied, the activity is assigned to an agent and an information packet associated with the activity is sent to the agent. (Column 12, Lines 47-53; Column 13, Lines 60-65; Figure 12). The agent then completes the activity and returns the information packet, and exit conditions of the activity are used to determine whether the activity has been completed. (Column 13, Line 49, through Column 14, Line 11; Figure 12).

D. Teschler

Teschler discloses information about the status and flow of projects being sent back and forth between entities. (Page 1, Lines 1-2 and 10-24)

E. Group 1 (Claims 1 and 3-4)

The Examiner rejects Claims 1 and 3-4 under *Randell* in view *Teschler*. Appellants respectfully submit that Claims 1 and 3-4 are allowable over the proposed *Randell-Teschler* combination.

Claims 1 and 3-4 are separately patentable from every other claim subject to the same rejection and recite limitations that are substantially different from limitations recited in all other claims. Therefore, Appellants have grouped Claims 1 amd 3-4 separately from all other claims.

Independent Claim 1 recites:

> A computer-implemented process operable, when executing on a computer system, to manage a distributed workflow involving a plurality of physically separated enterprises to perform a set of predefined, executable software functions that collectively perform the distributed workflow:
>
> the computer-implemented process operable, when executing on a computer system, to store the set of predefined, executable software functions for the distributed workflow involving the plurality of physically separated enterprises that are to be performed at a plurality of distributed nodes, each of the distributed nodes being associated with a corresponding one of the plurality of physically separated enterprises;

the computer-implemented process operable, when executing on the computer system, to manage the distributed workflow involving the plurality of physically separated enterprises by automatically interacting with the distributed workflow involving the plurality of physically separated enterprises at each of the distributed nodes associated with the plurality of physically separated enterprises to perform the predefined, executable software functions;

the computer-implemented process operable, when executing on the computer system, to communicate a first one or more of the predefined, executable software functions to a first one of the distributed nodes associated with a corresponding first one of the plurality of physically separated enterprises and, in connection with performance of the first one or more predefined, executable software functions at the first one of the distributed nodes, interact with the first one of the distributed nodes associated with the corresponding first one of the plurality of physically separated enterprises through performance of the first one or more predefined, executable software functions at the first one of the distributed nodes; and

the computer-implemented process operable, when executing on the computer system, to communicate a second one or more of the predefined, executable software functions to a second one of the distributed nodes associated with a corresponding second one of the plurality of physically separated enterprises and, in connection with performance of the second one or more predefined, executable software functions at the second one of the distributed nodes, interact with the second one of the distributed nodes associated with the corresponding second one of the plurality of physically separated enterprises through performance of the second one or more predefined, executable software functions at the second one of the distributed nodes, the second one or more predefined, executable software functions performed at the second one of the distributed nodes using as input a result of the performance of the first one or more predefined, executable software functions at the first one of the distributed nodes.

Even assuming for the sake of argument that *Randell* and *Teschler* could be combined with each other as the Examiner proposes, the proposed *Randell-Teschler* combination would still fail to disclose, teach, or suggest limitations recited in independent Claim 1.

As an example, nowhere does the proposed *Randell-Teschler* combination disclose, teach, or suggest, as recited in independent Claim 1, as amended:

- the computer-implemented process operable, when executing on the computer system, to communicate ***a first one or more of the predefined, executable software functions*** to a first one of the distributed nodes associated with a corresponding first one of the

plurality of physically separated enterprises and, in connection with performance of ***the first one or more predefined, executable software functions*** at the first one of the distributed nodes, ***interact with the first one of the distributed nodes associated with the corresponding first one of the plurality of physically separated enterprises through performance of the first one or more predefined, executable software functions at the first one of the distributed nodes***; or

- the computer-implemented process operable, when executing on the computer system, to communicate ***a second one or more of the predefined, executable software functions*** to a second one of the distributed nodes associated with a corresponding second one of the plurality of physically separated enterprises and, in connection with performance of ***the second one or more predefined, executable software functions*** at the second one of the distributed nodes, ***interact with the second one of the distributed nodes associated with the corresponding second one of the plurality of physically separated enterprises through performance of the second one or more predefined, executable software functions at the second one of the distributed nodes, the second one or more predefined, executable software functions*** performed at the second one of the distributed nodes using as input a result of the performance of ***the first one or more predefined, executable software functions*** at the first one of the distributed nodes.

Nowhere does *Randell* describe these recited ***predefined, executable software functions***. Instead, as discussed above, *Randell* merely discloses data defining an activity being communicated from a computer system to an agent so that the agent can perform the activity. In addition, as further discussed above, the examples of such data set forth in *Randell*—design specifications and cost information—clearly teach away from the possibility that such data could be properly considered the ***predefined, executable software functions*** recited in independent Claim 1. There is certainly no disclosure, teaching, or suggestion in *Randell* that its computer system ***interacts with one of the distributed nodes associated with one of the plurality of physically separated enterprises through performance of the one or more predefined, executable software functions at the distributed node***, as recited in independent Claim 1.

Teschler fails to make up for these deficiencies of *Randell*. As discussed above, *Teschler* merely discloses information about the status and flow of projects being sent back and forth between entities. Nowhere does *Teschler* disclose, teach, or suggest that such information includes the ***predefined, executable software functions*** recited in independent

Claim 1, much less any of the operations involving the ***predefined, executable software functions*** specifically recited in independent Claim 1. For example, there is no disclosure, teaching, or suggestion in *Randell* that its computer system ***interacts with one of the distributed nodes associated with one of the plurality of physically separated enterprises through performance of the one or more predefined, executable software functions at the distributed node***, as recited in independent Claim 1.

These deficiencies of *Randell* and *Teschler* individually, and of their proposed combination, are made even more apparent when the limitations discussed above are considered in the context of the numerous other limitations recited in independent Claim 1, which must be considered as a whole, with weight given to each and every one of its recited limitations.

For at least these reasons, the proposed *Randell-Teschler* combination fails to disclose, teach, or suggest all elements of independent Claim 1. Independent Claim 1 is therefore allowable over the proposed *Randell-Teschler* combination. Because dependent Claims 3 and 4 depend on independent Claim 1, dependent Claims 3 and 4 are therefore also allowable over the proposed *Randell-Teschler* combination.

F. Group 2 (Claim 2)

The Examiner rejects independent Claim 2 under *Randell* in view *Teschler*. Appellants respectfully submit that independent Claim 2 is allowable over the proposed *Randell-Teschler* combination.

Independent Claim 2 is separately patentable from every other claim subject to the same rejection and recites limitations that are substantially different from limitations recited in all other independent claims. Therefore, Appellants have grouped independent Claim 2 separately from all other claims.

Independent Claim 2 recites:

> A computer-implemented process operable, when executing on a computer system, to manage a distributed workflow to perform a set of predefined, executable software functions:
>
> the computer-implemented process operable, when executing on a computer system, to store a set of predefined, executable software functions for a workflow that are to be performed at a plurality of distributed nodes;
>
> the computer-implemented process operable, when executing on a computer system, to manage the workflow by automatically interacting with the workflow at each of the distributed nodes to perform the predefined, executable software functions; and
>
> the set of predefined, executable software functions operable to generate a workflow between a plurality of enterprises.

Even assuming for the sake of argument that *Randell* and *Teschler* could be combined with each other as the Examiner proposes, the proposed *Randell-Teschler* combination would still fail to disclose, teach, or suggest limitations recited in independent Claim 2.

As an example, nowhere does the proposed *Randell-Teschler* combination disclose, teach, or suggest, as recited in independent Claim 2:

- the computer-implemented process operable, when executing on a computer system, to store ***a set of predefined, executable software functions*** for a workflow that are to be performed at a plurality of distributed nodes;
- the computer-implemented process operable, when executing on a computer system, to manage the workflow by automatically interacting with the workflow at each of the distributed nodes to perform ***the predefined, executable software functions***; and
- ***the set of predefined, executable software functions*** operable to generate a workflow between a plurality of enterprises.

Nowhere does *Randell* describe these recited ***predefined, executable software functions***. Instead, as discussed above, *Randell* merely discloses data defining an activity being communicated from a computer system to an agent so that the agent can perform the activity. In addition, the examples of such data set forth in *Randell*—design specifications and cost information—clearly teach away from the possibility that such data could be properly considered the ***predefined, executable software functions*** recited in independent Claim 2.

Teschler fails to make up for these deficiencies of *Randell*. As discussed above, *Teschler* merely discloses information about the status and flow of projects being sent back and forth between entities. Nowhere does *Teschler* disclose, teach, or suggest that such information includes the ***predefined, executable software functions*** recited in independent Claim 2, much less any of the operations involving the ***predefined, executable software functions*** specifically recited in independent Claim 2.

These deficiencies of *Randell* and *Teschler* individually, and of their proposed combination, are made even more apparent when the limitations discussed above are considered in the context of the numerous other limitations recited in independent Claim 2, which must be considered as a whole, with weight given to each and every one of its recited limitations.

For at least these reasons, the proposed *Randell-Teschler* combination fails to disclose, teach, or suggest all elements of independent Claim 2. Independent Claim 2 is therefore allowable over the proposed *Randell-Teschler* combination.

G. Group 3 (Claims 5-7, 10-12, and 48)

The Examiner rejects Claims 5-7, 10-12, and 48 under *Randell* in view *Teschler*. Appellants respectfully submit that Claims 5-7, 10-12, and 48 are allowable over the proposed *Randell-Teschler* combination.

Claims 5-7, 10-12, and 48 are separately patentable from every other claim subject to the same rejection and recite limitations that are substantially different from limitations recited in all other claims. Therefore, Appellants have grouped Claims 5-7, 10-12, and 48 separately from all other claims.

Independent Claim 5 recites:

> A computer-implemented process for generating a collaboration between a plurality of enterprises, the computer-implemented process operating at least in part external to the enterprises, the computer-implemented process operable, when executing on a computer system, to:

receive at the computer system a preliminary collaboration from a first enterprise;

automatically transmit the preliminary collaboration from the computer-implemented process at the computer system to a predefined second enterprise for review;

receive at the computer system a response to the preliminary collaboration from the second enterprise;

automatically transmit the response of the second enterprise from the computer-implemented process at the computer system to the first enterprise for review; and

receive at the computer system a response to the response of the second enterprise from the first enterprise, the responses of the first and second enterprises ultimately resulting in a final collaboration based on the preliminary collaboration and optimized for the first and second enterprises.

Independent Claim 48 recites limitations substantially similar to limitations recited in independent Claim 5.

Even assuming for the sake of argument that *Randell* and *Teschler* could be combined with each other as the Examiner proposes, the proposed *Randell-Teschler* combination would still fail to disclose, teach, or suggest limitations recited in independent Claim 5.

As an example, nowhere does the proposed *Randell-Teschler* combination disclose, teach, or suggest, as recited in independent Claim 5, ***a computer-implemented process operable***, when executing on a computer system, ***to***:

- ***receive*** at the computer system ***a preliminary collaboration*** from a first enterprise; and
- ***automatically transmit the preliminary collaboration*** from the computer-implemented process at the computer system to a predefined second enterprise ***for review***.
- ***receive*** at the computer system ***a response to the preliminary collaboration*** from the second enterprise;
- ***automatically transmit the response*** of the second enterprise from the computer-implemented process at the computer system to the first enterprise ***for review***; and
- ***receive*** at the computer system ***a response to the response of the second enterprise*** from the first enterprise, the responses of the first and second enterprises ultimately ***resulting in a final collaboration based on the preliminary collaboration and optimized for the first and second enterprises***.

The Examiner asserts, without explanation, that certain portions of *Randell* disclose these limitations. However, contrary to the Examiner's assertion, those portions of *Randell* merely disclose entry conditions for starting an activity. If the entry conditions are satisfied, the activity is assigned to an agent and an information packet associated with the activity is sent to the agent. The agent then completes the activity and returns the information packet, and exit conditions of the activity are used to determine whether the activity has been completed. Nowhere do these portions of *Randell* disclose, teach, or suggest ***review*** of ***a preliminary collaboration*** involving the particular steps and resulting in the particular ***final collaboration*** recited in independent Claim 5.

Teschler fails to make for these deficiencies of *Randell*. Nowhere does *Teschler* disclose, teach, or suggest the workflow interoperability specification of *Teschler* even ***generating a collaboration***, much less the workflow interoperability specification of *Teschler* generating a collaboration according to the particular limitations specifically recited in independent Claim 5.

These deficiencies of *Randell* and *Teschler* individually, and of their proposed combination, are made even more apparent when the limitations discussed above are considered in the context of the numerous other limitations recited in independent Claim 5, which must be considered as a whole, with weight given to each and every one of its recited limitations.

For at least these reasons, the proposed *Randell-Teschler* combination fails to disclose, teach, or suggest all elements of independent Claims 5 and 48. Independent Claims 5 and 48 are therefore allowable over the proposed *Randell-Teschler* combination. Because dependent Claims 6-7 and 10-12 depend on independent Claim 5, dependent Claims 6-7 and 10-12 are therefore also allowable over the proposed *Randell-Teschler* combination.

H. Group 4 (Claims 15-19)

The Examiner rejects Claims 15-19 under *Randell* in view *Teschler*. Appellants respectfully submit that Claims 15-19 are allowable over the proposed *Randell-Teschler* combination.

Claims 15-19 are separately patentable from every other claim subject to the same rejection and recite limitations that are substantially different from limitations recited in all other claims. Therefore, Appellants have grouped Claims 15-19 separately from all other claims.

Independent Claim 15 recites:

> A computer-implemented process for deploying a collaboration generated by a first enterprise to a plurality of other enterprises, the computer-implemented process operating at least in part external to the enterprises, the computer-implemented process operable, when executing on a computer system, to:
>
> receive a final collaboration approved by first, second, and third enterprises;
>
> automatically transmit a predefined first part of the collaboration from the computer-implemented process to a predefined second enterprise for operation at the second enterprise; and
>
> automatically transmit a predefined second part of the collaboration from the computer-implemented process to a predefined third enterprise for operation at the third enterprise.

Even assuming for the sake of argument that *Randell* and *Teschler* could be combined with each other as the Examiner proposes, the proposed *Randell-Teschler* combination would still fail to disclose, teach, or suggest limitations recited in independent Claim 15 of the present Application.

As an example, nowhere does the proposed *Randell-Teschler* combination disclose, teach, or suggest ***a computer-implemented process operable***, when executing on a computer system, ***to receive a final collaboration approved by first, second, and third enterprises***, as recited in independent Claim 15. As discussed above, *Randell* merely discloses exit

conditions being used to determine whether a single activity that has been dispatched to a single agent has been completed. As further discussed above, *Teschler* merely discloses information about the status and flow of projects being sent back and forth between retailers, distributors, and manufacturers. Thus, even assuming for the sake of argument that an activity of *Randell* or a project of *Teschler* could be properly considered ***a final collaboration***, the proposed *Randell-Teschler* combination would still fail to disclose, teach, or suggest that the activity or project is ***approved by first, second, and third enterprises***, as recited in independent Claim 15.

Because the proposed *Randell-Teschler* combination fails to disclose, teach, or suggest ***a final collaboration approved by first, second, and third enterprises***, the proposed *Randell-Teschler* combination also necessarily fails to disclose, teach, or suggest, as recited in independent Claim 15, the ***computer-implemented process operable to***, when executing on a computer system:

- ***automatically transmit a predefined first part of the collaboration*** from the computer-implemented process ***to a predefined second enterprise for operation at the second enterprise***; and
- ***automatically transmit a predefined second part of the collaboration*** from the computer-implemented process ***to a predefined third enterprise for operation at the third enterprise***.

These deficiencies of *Randell* and *Teschler* individually, and of their proposed combination, are made even more apparent when the limitations discussed above are considered in the context of the numerous other limitations recited in independent Claim 15, which must be considered as a whole, with weight given to each and every one of its recited limitations.

For at least these reasons, the proposed *Randell-Teschler* combination fails to disclose, teach, or suggest all elements of independent Claim 15. Independent Claim 15 is therefore allowable over the proposed *Randell-Teschler* combination. Because dependent Claims 16-19 depend on independent Claim 15, dependent Claims 16-19 are therefore also allowable over the proposed *Randell-Teschler* combination.

I. Group 5 (Claim 20)

The Examiner rejects independent Claim 20 under *Randell* in view *Teschler*. Appellants respectfully submit that independent Claim 20 is allowable over the proposed *Randell-Teschler* combination.

Independent Claim 20 is separately patentable from every other claim subject to the same rejection and recites limitations that are substantially different from limitations recited in all other independent claims. Therefore, Appellants have grouped Claim 20 separately from all other claims.

Independent Claim 20 recites:

> A computer-implemented process for monitoring a collaboration across a plurality of enterprises, the computer-implemented process operating at least in part external to the enterprises, the computer-implemented process operable, when executing on a computer system, to:
>
> receive at the computer system a first predefined set of data associated with operation of a first portion of the collaboration at a first node of a first enterprise, the first set of data having been collected in response to an automatic query of the first node for the first set of data;
>
> automatically transmit the first set of data from the computer-implemented process at the computer system to a monitoring system in response to the querying of the first node;
>
> receive at the computer system a second predefined set of data associated with operation of a second portion of the collaboration at a second node of a second enterprise, the second set of data having been collected in response to an automatic query of the second node for the second set of data; and
>
> automatically transmit the second set of data from the computer-implemented process at the computer system to the monitoring system in response to the querying of the second node.

Even assuming for the sake of argument that *Randell* and *Teschler* could be combined with each other as the Examiner proposes, the proposed *Randell-Teschler* combination would still fail to disclose, teach, or suggest limitations recited in independent Claim 20.

As an example, nowhere does the proposed *Randell-Teschler* combination disclose, teach, or suggest, as recited in independent Claim 20, ***the computer-implemented process operable to***, when executing on a computer system:

- ***receive*** at the computer system ***a first predefined set of data*** associated with operation of a first portion of the collaboration at a first node of a first enterprise, the first set of data ***having been collected in response to an automatic query of the first node for the first set of data***; and
- ***receive*** at the computer system ***a second predefined set of data*** associated with operation of a second portion of the collaboration at a second node of a second enterprise, the second set of data ***having been collected in response to an automatic query of the second node for the second set of data***.

As discussed above, *Randell* merely discloses entry conditions for starting an activity. If the entry conditions are satisfied, the activity is assigned to an agent and an information packet associated with the activity is sent to the agent. Even assuming for the sake of argument that an agent of *Randell* could be properly considered ***a first node*** or ***a second node***, *Randell* would still fail to disclose, teach, or suggest ***a first predefined set of data having been collected in response to an automatic query of*** the agent ***for the first set of data*** or ***a second predefined set of data having been collected in response to an automatic query of*** the agent ***for the second set of data***. *Teschler* fails to make for these deficiencies of *Randell*. As discussed above, *Teschler* merely discloses information about the status and flow of projects being sent back and forth between retailers, distributors, and manufacturers.

Because the proposed *Randell-Teschler* combination fails to disclose, teach, or suggest ***a first predefined set of data having been collected in response to an automatic query of the first node for the first set of data*** or ***a second predefined set of data having been collected in response to an automatic query of the second node for the second set of data***, the proposed *Randell-Teschler* combination also necessarily fails to disclose, teach, or suggest, as recited in independent Claim 20, ***the computer-implemented process operable to***, when executing on a computer system:

- ***automatically transmit the first set of data*** from the computer-implemented process at the computer system ***to a monitoring system in response to the querying of the first node***; and

- ***automatically transmit the second set of data*** from the computer-implemented process at the computer system ***to the monitoring system in response to the querying of the second node.***

These deficiencies of *Randell* and *Teschler* individually, and of their proposed combination, are made even more apparent when the limitations discussed above are considered in the context of the numerous other limitations recited in independent Claim 20, which must be considered as a whole, with weight given to each and every one of its recited limitations.

For at least these reasons, the proposed *Randell-Teschler* combination fails to disclose, teach, or suggest all elements of independent Claim 20. Independent Claim 20 is therefore allowable over the proposed *Randell-Teschler* combination.

Conclusion

Appellants have demonstrated that the present invention, as claimed, is clearly distinguishable over the prior art cited by the Examiner. Therefore, Appellants respectfully request the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner and instruct the Examiner to issue a notice of allowance of all claims.

Appellants have enclosed a check in the amount of $330.00 for this Appeal Brief. Appellants believe no additional fees are due. However, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Appellants

Christopher W. Kennerly
Reg. No. 40,675

Date: September 1, 2004

Correspondence Address:

Customer Number: 05073

Appendix A

1. A computer-implemented process operable, when executing on a computer system, to manage a distributed workflow involving a plurality of physically separated enterprises to perform a set of predefined, executable software functions that collectively perform the distributed workflow:

the computer-implemented process operable, when executing on a computer system, to store the set of predefined, executable software functions for the distributed workflow involving the plurality of physically separated enterprises that are to be performed at a plurality of distributed nodes, each of the distributed nodes being associated with a corresponding one of the plurality of physically separated enterprises;

the computer-implemented process operable, when executing on the computer system, to manage the distributed workflow involving the plurality of physically separated enterprises by automatically interacting with the distributed workflow involving the plurality of physically separated enterprises at each of the distributed nodes associated with the plurality of physically separated enterprises to perform the predefined, executable software functions;

the computer-implemented process operable, when executing on the computer system, to communicate a first one or more of the predefined, executable software functions to a first one of the distributed nodes associated with a corresponding first one of the plurality of physically separated enterprises and, in connection with performance of the first one or more predefined, executable software functions at the first one of the distributed nodes, interact with the first one of the distributed nodes associated with the corresponding first one of the plurality of physically separated enterprises through performance of the first one or more predefined, executable software functions at the first one of the distributed nodes; and

the computer-implemented process operable, when executing on the computer system, to communicate a second one or more of the predefined, executable software functions to a second one of the distributed nodes associated with a corresponding second one of the plurality of physically separated enterprises and, in connection with performance of the second one or more predefined, executable software functions at the second one of the distributed nodes, interact with the second one of the distributed nodes associated with the corresponding second one of the plurality of physically separated enterprises through

performance of the second one or more predefined, executable software functions at the second one of the distributed nodes, the second one or more predefined, executable software functions performed at the second one of the distributed nodes using as input a result of the performance of the first one or more predefined, executable software functions at the first one of the distributed nodes.

2. A computer-implemented process operable, when executing on a computer system, to manage a distributed workflow to perform a set of predefined, executable software functions:

the computer-implemented process operable, when executing on a computer system, to store a set of predefined, executable software functions for a workflow that are to be performed at a plurality of distributed nodes;

the computer-implemented process operable, when executing on a computer system, to manage the workflow by automatically interacting with the workflow at each of the distributed nodes to perform the predefined, executable software functions; and

the set of predefined, executable software functions operable to generate a workflow between a plurality of enterprises.

3. The process of Claim 1, wherein the set of predefined, executable software functions are operable to transmit data associated with operation of the distributed workflow involving the plurality of physically separated enterprises at each of the distributed nodes associated with the plurality of physically separated enterprises to a monitoring system.

4. The process of Claim 1, wherein the set of predefined, executable software functions are operable to deploy the distributed workflow involving the plurality of physically separated enterprises to the distributed nodes associated with the plurality of physically separated enterprises.

5. A computer-implemented process for generating a collaboration between a plurality of enterprises, the computer-implemented process operating at least in part external to the enterprises, the computer-implemented process operable, when executing on a computer system, to:

receive at the computer system a preliminary collaboration from a first enterprise;

automatically transmit the preliminary collaboration from the computer-implemented process at the computer system to a predefined second enterprise for review;

receive at the computer system a response to the preliminary collaboration from the second enterprise;

automatically transmit the response of the second enterprise from the computer-implemented process at the computer system to the first enterprise for review; and

receive at the computer system a response to the response of the second enterprise from the first enterprise, the responses of the first and second enterprises ultimately resulting in a final collaboration based on the preliminary collaboration and optimized for the first and second enterprises.

6. The process of Claim 5, wherein the response of the first enterprise comprises a comment on the preliminary collaboration.

7. The process of Claim 5, wherein the response of the first enterprise comprises a modification of the preliminary collaboration.

8-9. (Cancelled)

10. The process of Claim 5, further operable, when executing on a computer system, to;

receive at the computer system an approval from each of the first and second enterprises for a collaboration based on the preliminary collaboration and reflecting the responses of the first and second enterprises;

subsequent to receiving at the computer system the approvals from the first and second enterprises, automatically transmit the collaboration from the computer-implemented process at the computer system to a predefined third enterprise for review;

receive at the computer system a response to the collaboration from the third enterprise;

automatically transmit the response of the third enterprise from the computer-implemented process at the computer system to the first and second enterprises for review; and

receive at the computer system responses to the response of the third enterprise from the first and second enterprises, the responses of the first, second, and third enterprises ultimately resulting in a final collaboration based on the preliminary collaboration and optimized for the first, second, and third enterprises.

11. The process of Claim 10, wherein the response of the third enterprise comprises a comment on the collaboration.

12. The process of Claim 10, wherein the response of the third enterprise comprises a modification to the collaboration.

13-14. (Cancelled)

15. A computer-implemented process for deploying a collaboration generated by a first enterprise to a plurality of other enterprises, the computer-implemented process operating at least in part external to the enterprises, the computer-implemented process operable, when executing on a computer system, to:

receive a final collaboration approved by first, second, and third enterprises;

automatically transmit a predefined first part of the collaboration from the computer-implemented process to a predefined second enterprise for operation at the second enterprise; and

automatically transmit a predefined second part of the collaboration from the computer-implemented process to a predefined third enterprise for operation at the third enterprise.

16. The process of Claim 15, further operable, when executing on a computer system, to:

request an approval from the second enterprise for operation of the first part of the collaboration at a node of the second enterprise; and

request an approval from the third enterprise for operation of the second part of the collaboration at a node of the third enterprise.

17. The process of Claim 16, when executing on a computer system, further operable to, in response to receiving the approval from the second enterprise, notify the third enterprise of the approval.

18. The process of Claim 16, when executing on a computer system, further operable to, in response to receiving the approvals from the second and third enterprises, transmit a signal to the second and third enterprises to operate the first and second parts of the collaboration, respectively.

19. The process of Claim 16, when executing on a computer system, further operable to, in response to receiving approvals to operate the collaboration from all enterprises to which any part of the collaboration was transmitted, transmit a signal to all of the enterprises to which any part of the collaboration was transmitted to operate the corresponding transmitted parts of the collaboration.

20. A computer-implemented process for monitoring a collaboration across a plurality of enterprises, the computer-implemented process operating at least in part external to the enterprises, the computer-implemented process operable, when executing on a computer system, to:

receive at the computer system a first predefined set of data associated with operation of a first portion of the collaboration at a first node of a first enterprise, the first set of data having been collected in response to an automatic query of the first node for the first set of data;

automatically transmit the first set of data from the computer-implemented process at the computer system to a monitoring system in response to the querying of the first node;

receive at the computer system a second predefined set of data associated with operation of a second portion of the collaboration at a second node of a second enterprise, the second set of data having been collected in response to an automatic query of the second node for the second set of data; and

automatically transmit the second set of data from the computer-implemented process at the computer system to the monitoring system in response to the querying of the second node.

21-47. (Cancelled)

48. A computer-implemented process for generating a collaboration between a plurality of enterprises, the computer-implemented process operating at least in part external to the plurality of enterprises, the computer-implemented process comprising:

means for receiving a preliminary collaboration from a first enterprise;

means for automatically transmitting the preliminary collaboration to a predefined second enterprise for review;

means for receiving a response to the preliminary collaboration from the second enterprise;

means for automatically transmitting the response of the second enterprise to the first enterprise for review; and

means for receiving a response to the response of the second enterprise from the first enterprise, the responses of the first and second enterprises ultimately resulting in a final collaboration based on the preliminary collaboration and optimized for the first and second enterprises.

Appendix B

6/7/3
DIALOG(R)File 636:Gale Group Newsletter DB(TM)

03875999 Supplier Number: 48462860 (THIS IS THE FULLTEXT)
***STAFFWARE*: *Staffware* in first web only WFMC interoperability demonstration**
M2 Presswire, pN/A
May 4, 1998
TEXT:
M2 PRESSWIRE-4 May 1998-*STAFFWARE*: *Staffware* in first web only WFMC interoperability demonstration (C)1994-98 M2 COMMUNICATIONS LTD
RDATE:010598 * *Staffware* Global V2 showcased in web based inter enterprise supply chain scenario *Staffware* plc, the leading developer of *workflow* solutions, will play a key role in an industry sponsored *workflow* and document management software interoperability demonstration at the AIIM 98 show in the USA next month. The demonstration will illustrate the business value of software standards as organisations strive to manage mission critical processes and information within and between enterprises. Sponsored by the *Workflow* Management Coalition (WfMC) and Document Management Alliance (DMA), the live interoperability demonstration will take place in the 'Standards at Work' pavilion at AIIM 98 in Anaheim, California, during the show from 12 to 14 May. Large enterprises are recognising the benefits of business process automation and document management that empowers workforces enhancing customer service and improving efficiency. Increasingly, organisations are using Internet technologies to enable distributed workers as well as customers and suppliers using *multiple* IT environments to take part in business procedures. Managing processes across its own company as well as other organisations demands standards. Reflecting the emergence of the Internet in commerce, the demonstration will be based solely on Internet technologies including the first showing of *Staffware* Global V2, the latest version of the company's Java based *workflow* client. Launched at the AIIM Show last year, *Staffware* Global was the first Web based *workflow* client. Elsewhere at the Show, *Staffware* will be previewing an all new HTML based client. The WfMC interoperability standard allows *workflow* systems from *multiple* vendors to be *linked*. Business processes that span *multiple* organisations can therefore be automated from start to finish. In the demonstration *Staffware* will be showing a Document Management Alliance module which allows *Staffware* to access a number of documents using the DMA standard, regardless of which vendor's repository they are stored in. John O'Connell, *Staffware*, CEO and founder, said: "*Staffware* software already supports many of the WfMC interoperability specifications. The AHM 98 demonstration will show how organisations can easily use *Staffware* *workflow* to enhance their technology investments by improving access to and use of information both within and between enterprises. "*Staffware* has long been committed to developing and supporting industry standards being a founding member of the WfMC and member of AHM. Senior *Staffware* officers play an active role in both bodies holding prominent position in the WfMC and AIIM," concluded O'Connell. *Staffware* Plc *Staffware* is the founder of the independent *workflow* industry. With over 250,000 users, it is also the market leader with a 25% global market share in 1997*. According to recent independent surveys, *Staffware* is one of the top 50 software companies in Europe and one of the top 200 globally. It is also the fastest growing organisation in the *workflow*/document management sector worldwide. Authored and distributed by *Staffware*, its *workflow* software is marketed in over 4.0 countries worldwide. The *Staffware* product enables the rapid development of *workflow* solutions that automate business rules and processes in order to improve customer service, competitive advantage, organisational productivity and tighter adherence to regulatory requirements. *Staffware* operates on a wide range of IT platforms and is deployable on thin client and client/server based architectures. It integrates with third party applications notably imaging, document management and line of business, systems to fully support any corporate computing strategy. Fully committed

to industry standards, *Staffware* is a founder member of the *Workflow* Management Coalition and InterForum in the UK. *Staffware has executives in senior positions at AIIM international, the leading not for profit industry association. Headquartered in Maidenhead in the UK, the company employs over 200 staff worldwide with access to over 1,000 *Staffware* *workflow* consultants through a network of partners, resellers and OEMs, including IBM, Microsoft, Digital, ICL, Sema, Sun and Unisys. CONTACT: Nick Kingsbury, *Staffware* Plc Tel: +44 (0)1628 786800 Fax: +44 (0)162B 781654 Richard Merrin/Alex Laity, Spreckley Pittham Ltd Tel: +44 (0)171 388 9988 Tel: +44 (0)171 388 8588 *M2 COMMUNICATIONS DISCLAIMS ALL LIABILITY FOR INFORMATION PROVIDED WITHIN M2 PRESSWIRE. DATA SUPPLIED BY NAMED PARTY/PARTIES.*

3/9/1 (Item 1 from file: 15)
DIALOG(R)File 15:ABI/Inform(R)

01282223 99-31619

Demo proves it--workflow spec lets messages flow

Teschler, Leland

Machine Design v68n15 PP: 74-75 Aug 22, 1996 CODEN: MADEAP ISSN: 0024-9114 JRNL CODE: MDS
DOC TYPE: Journal article LANGUAGE: English LENGTH: 2 Pages
WORD COUNT: 433

ABSTRACT: A public demonstration of a new *Workflow* *Interoperability* Specification devised by an organization called the Workflow Management Coalition has shown that the road has been cleared for software from different vendors to communicate about the status and flow of projects.

TEXT: The road has been cleared for software from different vendors to communicate about the status and flow of projects, their "workflow."

That is one of the conclusions to come out of a public demonstration of a new *Workflow* *Interoperability* Specification devised by an organization called the Workflow Management Coalition. The demonstration, which took place at the recent Workflow Canada Conference in Toronto, involved workflow software from IBM, Digital, Microsoft, Staffware, and Wang. Packages from these vendors all exchanged information as part of three supply chain management scenarios.

The demonstrations involved sending information back and forth as it might flow between entities such as retailers, distributors, and manufacturers. The simulated tasks that took place included such actions as checking order status, receiving notification of completed actions, updating inventory information, and other bookkeeping associated with projects, goods, or services that span between more than one company or department.

The significance of the demonstration goes beyond simple order processing, say organizers. "Though the demo was in supply chain management, it was just an example. Multiple companies or departments that are autonomous but need to cooperate are the ideal candidates for applying this spec," says Sunil Sarin, chairman of the Coalition's Interoperability Workgroup and workflow product architect with InConcert, a Xerox new enterprise company. "At the level the spec deals with, the participating software needn't be a workflow engine. MRP or PDM software having workflow functions can use it to exchange messages."

The term "workflow software" refers to packages that basically keep track of projects or act as coordinators of events moving through different stages of completion. Such packages generally track such factors as project status, delay times, commitments made by participants, waiting times, and similar issues.

Though there can be overlap between workflow packages and other software disciplines such as electronic data interchange (EDI), the new workflow specification goes deeper than these earlier standards. "EDI focuses on what is going on in individual messages. There is no notion of a process that spans multiple messages," says Sarin. "The interoperability spec adds the concept that messages are part of a workflow process."

The new specification is designed so that interoperability functions easily add to existing software without modifying core functions. "The challenge was defining the scope of the specification clearly and narrowly enough so there wouldn't be technical barriers preventing different packages from cooperating," says Sarin. "The requesting software needs no knowledge of

how the message recipient implements a request. Software only needs to know the name of the process and its inputs and outputs. There is no need for it to understand anything else across systems."

GEOGRAPHIC NAMES: US
DESCRIPTORS: Information systems; Management controls; Workflow software; Applications; Advantages; Manycompanies
CLASSIFICATION CODES: 9000 (CN=Short Article); 9190 (CN=United States); 5240 (CN=Software & systems)
?

Appendix C